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Patent

Attorney's Docket No. 000270-018

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
)
 Steven L. STICE et al) Group Art Unit: 1633
)
 Application No.: 09/004,606) Examiner: Unassigned
)
 Filed: January 8, 1998)
)
 For: CLONING USING DONOR NUCLEI)
 FROM DIFFERENTIATED FETAL)
 AND ADULT CELLS)

RECEIVED
SEP 15 1998
OFFICE OF PLENTION

PETITION UNDER 37 C.F.R. §1.47(a)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

The above-identified Patent Application is being filed pursuant to 37 C.F.R. §1.47(a). This Application was filed without a signed Declaration and Assignment by the inventors, which are Steven L. Stice, Jose Cibelli, James M. Robl, Paul Golueke, and D. Joseph Jerry, on January 8, 1998. This Petition is necessary because one of the joint inventors, Paul Golueke, has refused to sign the Declaration pursuant to 37 C.F.R. §1.63.

In support of this Petition, Applicants enclose the following:

- (1) Declaration Pursuant to 37 C.F.R. §1.63 signed by the remaining joint inventors on behalf of themselves and the non-signing inventor;

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(2) Declaration of Facts by the undersigned, substantiating that the above-identified Application, Declaration and Assignment papers were provided to Paul Golueke at his current address, that these papers were received by Paul Golueke, and that he refused to sign these papers after receipt.

Also, the requisite fee of \$130.00 is provided in accordance with 37 C.F.R. §1.17(h), as well as the four month Extension of Time fee of \$755.00, in accordance with 37 C.F.R. §1.16(e) which is required for the late filing of the signed Declaration.

It is respectfully requested, based on the provided information, that this Patent Application be accepted pursuant to 37 C.F.R. §1.47(a) because Applicants have fully complied with the requirements of 35 U.S.C. §116, second paragraph, and 37 C.F.R. §1.47(a).

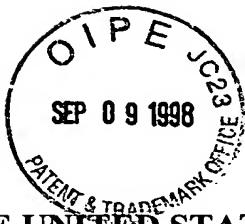
Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: Robin L. Teskin
Robin L. Teskin
Registration No. 35,030

P.O. Box 1404
Alexandria, VA 22313-1404
(703) 836-6620

Date: September 9, 1998



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U.S. PATENT AND TRADEMARK OFFICE

DECLARATION OF FACTS PURSUANT TO 37 C.F.R. §1.47(a)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

I, Robin L. Teskin, declare and state as follows:

- (1) That I am a registered Patent Attorney who prepared and am responsible for the prosecution of the above-identified Patent Application.
- (2) That I am responsible for prosecution of this application based on my representation of Advanced Cell Technology (ACT), the exclusive Licensee of the subject Application.
- (3) That promptly after preparation and filing of this Patent Application, I provided a complete copy of this Patent Application, including the Claims,

Specification and Abstract, along with a Declaration and Assignment for execution by the inventors. In accordance with previous instructions and dealings with this client, ACT, I forwarded a complete copy of these documents initially to Steven L. Stice, who forwarded the documents to the remaining inventors for the requisite signatures.

(4) That sometime early in May of 1998, I received from Dr. Stice the Declaration and Assignment documents which had been executed by all of the inventors except for Paul Golueke. I was thereupon advised by Dr. Stice that Paul Golueke might not be willing to sign the Declaration and Assignment since he had recently terminated his employment with Advanced Cell Technology. However, Dr. Stice indicated that I should independently attempt to obtain the signature of Paul Golueke in accordance with 37 C.F.R. §1.63.

(5) Accordingly, thereupon on May 14, 1998, I provided a complete copy of the as-filed Patent Application, including the Declaration and Assignment received by Dr. Stice, which had been signed by all the inventors with the exception of Paul Golueke. I further sent a letter requesting that Mr. Golueke sign, date and return these documents to us by June 9, 1998, so that they could be filed in the U.S. Patent and Trademark Office. A copy of this letter is attached as Exhibit 1 to this Declaration.

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(6) After I had not received the signed documents as of June 9, 1998, I thereupon attempted to contact Paul Golueke by telephone. I learned that his address had since changed and was 620 Constitution Avenue, Deforest, Wisconsin 53532. I thereupon obtained his new telephone number. I then contacted him by telephone and advised him that I would be sending him a reminder letter requesting that he provide us the executed Declaration and Assignment documents with his signature in order to avoid incurring additional government extension fees. In this letter, which was sent via air courier on June 15, 1998, I requested that he return the executed Declaration and Assignment to our Offices for filing in the Patent and Trademark Office prior to July 9, 1998. A copy of this letter is attached to this Declaration as Exhibit 2.

(7) On July 2, 1998, when I still had not received the signed documents, I again contacted Paul Golueke by telephone and further requested in a letter, sent via air courier, that he provide us the executed Declaration and Assignment documents. Further, I also requested at that time that, if he was unwilling to sign these documents, that he return the documents (because they contained the signatures of the other inventors). A copy of this letter is attached as Exhibit 3.

(8) On July 13, 1998, I received from Paul Golueke the Declaration Pursuant to 37 C.F.R. §1.63 which had been previously signed by all of the remaining inventors,

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as well as the Assignment which, likewise, was signed by all of the inventors with the exception of Paul Golueke. (A copy of the courier envelope sent to our Offices by Paul Golueke is attached as Exhibit 4.)

(9) Thus, based on the foregoing, I advised the other inventors that I would be preparing a Petition requesting that this Application be accorded §1.47(a) status based on the refusal of Paul Golueke to sign the inventorship Declaration.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: September 9, 1998



Robin L. Teskin

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

ATTORNEYS AT LAW

EXHIBIT

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PATENT AGENT

† CALIFORNIA BAR
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* BARS OTHER THAN VA. CA & NC

May 14, 1998

Paul Golueke, Ph.D.
8 Diane Drive #3,
Belchertown, MA 01007

VIA UPS COURIER

Re: U.S. Patent Application Serial No. 09/004,606
(CIP of Serial No. 08/888,057, in turn, CIP of 08/781,752)
"Cloning Using Donor Nuclei From
Differentiated Fetal and Adult Cells"
Our Reference: 000270--018

Dear Paul:

Enclosed please find an Assignment and Combined Declaration and Power of Attorney for your signature. Please sign, date, and return these documents to us by June 9, 1998, for submission in the U.S. Patent and Trademark Office.

Sincerely,

Robin L. Teskin

RLT:kdd
Enclosures

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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EXHIBIT

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June 15, 1998

Paul Golueke, Ph.D.
620 Constitution Lane
DeForest, Wisconsin 53532

VIA UPS COURIER

Re: U.S. Patent Application Serial No. 09/004,606
(CIP of Serial No. 08/888,057, in turn, CIP of 08/781,752)
"Cloning Using Donor Nuclei From
Differentiated Fetal and Adult Cells"
Our Reference: 000270-018

Dear Paul:

In accordance with our recent telephone conversation, enclosed please a copy of the Application as filed in the above-identified case.

We still await receipt of the executed Declaration and Assignment forwarded to you under our letter of May 14, 1998. In order to avoid additional governmental fees, the executed Declaration must be filed prior to July 9, 1998. We look forward to receiving the documents prior to the due date.

Please do not hesitate to contact us if you have any questions concerning this matter.

Sincerely,

Robin Teskin/kd

Robin L. Teskin

RLT:kdd

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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Dear Paul:

Following our letters of May 14 and June 15, 1998, we still await receipt of the executed Declaration and Assignment documents. Please return these documents as soon as possible, no later than July 13, 1998.

If you will not be signing these documents, please return the papers to our office by Monday, July 13, since they contain the original signatures of the other inventors.

Please do not hesitate to contact me as soon as possible if any questions arise.

Sincerely,

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